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**Pre-Appeal Brief Request for Review
PATENT APPLICATION
Docket No. 15436.307.1**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop **APPEAL**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the clear errors and omissions in the rejections. In addition, Applicants request that the Panel carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Panel's understanding.

PRIOR ART REJECTIONS

The Applicant cites to clear error in the Office Action as the Examiner (1) has made inconsistent characterizations of the prior art, (2) has failed to make the required comparison of the facts of the legal precedent relied upon in the Office Action to the facts of this case, and (3) has applied the incorrect legal precedent.

First, the Examiner rejects claim 39 under 35 U.S.C. § 102(b) as being anticipated by *Aronson* (International Publication WO02063800A1). However, the assertions on page 2 of the Office Action alleging that the integrated circuits of claim 39 are taught by *Aronson* are in direct contrast to the Examiner's statements on page 4 of the office action where the Examiner admits that "*Aronson* does not teach that the components are all on one integrated circuit."

For example, claim 39 requires an integrated circuit that includes the following elements:

- a receiver substrate that includes a power line and a conductive path;
- a photodiode mounted on the receiver substrate;
- an optical converter communicably connected with the photodiode, the optical converter for converting a received optical signal into an electrical signal;
and
- a processing control mounted on the receiver substrate, the processing control communicably connected with one or more of the photodiode, the power line, and the conductive path, the processing control comprising a memory portion, the memory portion comprising one or more memory components for receiving or storing data.

On page 2 of the Office Action the Examiner alleges that Aronson teaches this integrated circuit of claim 39. However, in the 103 rejections the Examiner admits that *Aronson* does not teach that the components are all on one integrated circuit, which is in direct contrast to the 102 rejection. For example, the Examiner admits that Aronson does not teach the integrated circuit of claim 10, which includes the following elements:

- a receiver substrate that includes a power line and a conductive path;
- a photodiode mounted on the receiver substrate;
- an optical converter communicably connected with the photodiode, the optical converter for converting a received optical signal into an electrical signal;
and
- a processing control mounted on the receiver substrate, the processing control communicably connected with one or more of the photodiode, the power line, and the conductive path, the processing control comprising a memory

portion, the memory portion comprising one or more memory components for receiving or storing data.

Thus, the Examiner has proposed inconsistent positions. As such, the Applicants cite to this clear error as well and respectfully request that the rejection of claim 39 be withdrawn.

Second, the Examiner rejects claims 1-4, 6-11, 13, 15-19, 21-23, 25-27, 32-34, 36, and 38 under 35 U.S.C. § 103 as being unpatentable over *Aronson* providing only a conclusory statement as to the applicability of legal precedent. On page 4 of the Office Action, the Examiner admits that “*Aronson* does not teach that the components are all on one integrated circuit.” However, according to the Examiner, “It would have been obvious to one of ordinary skill in the art at the time of the invention to integrate the assembly of *Aronson* on an integrated circuit, since it has been held that the use of a one piece construction instead of the non-integrated structure of the prior art would be merely a matter of obvious engineering choice.” Citing to *In re Larson* 340 F.2d 965, 968 (CCPA 1965). The Examiner does not, however, discuss the facts of *Larson* and make the required explicit comparison to the facts of this case to establish that they are sufficiently similar.

It is clear from MPEP 2144, and in particular MPEP 2144.04, that a factual comparison must be made for a *prima facie* case to be based on legal precedent. More specifically, MPEP 2144 states:

LEGAL PRECEDENT CAN PROVIDE THE RATIONALE SUPPORTING OBVIOUSNESS ONLY IF THE FACTS IN THE CASE ARE SUFFICIENTLY SIMILAR TO THOSE IN THE APPLICATION

The examiner must apply the law consistently to each application after considering all the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

(Emphasis added). Similarly, MPEP 2144.04 states the following:

2144.04 Legal Precedent as Source of Supporting Rationale [R-1]

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

(Emphasis added).

Thus, the Examiner must explicitly establish on the record that the facts in *Larson* are sufficiently similar to those in this application to rely on *Larson* in a rejection. Because no such comparison has been made, the rejection is based on clear error and the Applicants respectfully request that the rejection be withdrawn.

Finally, *Larson* does not apply here where *Larson* relates to the obviousness of making integral two elements which were previously separate, as opposed to omitting an element while retaining its function as we have here. *Larson* related to the integration of a brake drum with a clamping means. However, in *Larson* neither the brake drum nor the clamping means were omitted from the claimed invention, rather they were simply made integral.

Here, the claims clearly set forth that various components are included within a single integrated circuit. Thus, in many embodiments, circuit traces, multiple substrates, connectors, and/or one or more additional integrated circuit(s) are eliminated providing the many benefits disclosed in the Applicant's specification. For example, elimination of additional integrated circuit(s) and/or circuit trace(s), while retaining their functions, may result in reduced effects of discontinuities. Moreover, there may be fewer changes in shape of conductive paths, less mismatched electrical impedances, reduced electronic signal reflections, improved signal rise and fall edges, and eliminated or reduced need for conventional methods of compensation and their components, such as matching components, which are particularly important in high-frequency data transmission systems. See paragraphs [0011] – [0015], [0039], [0045], and [0055] of the Applicant's disclosure.

Omission of an element with retention of the element's function is an indicia unobviousness. MPEP 2144.04(II)(B) (emphasis added) citing to *In re Edge*, 359 F.2d 896 (CCPA 1966). In *Edge*, the claims were found unobvious over the prior art because although the transparent layer of the prior art was eliminated, the function of the transparent layer was retained. Similarly, here the Applicant has eliminated additional integrated circuit(s), trace(s), and/or substrate(s) and retained the function in a single integrated circuit. Therefore, the Applicant submits that *Larson* is inapplicable, rather the applicable case law is *Edge* and MPEP 2144.04(II)(B). As such, the Applicants cite to clear error for this reason as well.

CONCLUSION

In view of the foregoing, Applicants believe the rejections are based on clear error. In the event that the Panel finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 21st day of May, 2007.

Respectfully submitted,

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